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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671

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[REDACTED] EXAMINER

JOHNSON, MARLON B

ART UNIT	PAPER NUMBER
2153	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/385,802	BARTHOLOMEN DONOVAN, KEVIN REMINGTON JOS	
Examiner	Art Unit		
Marlon Johnson	2153		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 09 April 2003.

2a)  This action is **FINAL**.                  2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-8,10-20,22 and 23 is/are pending in the application.  
    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8,10-20,22 and 23 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6)  Other: \_\_\_\_\_.

## Detailed Action

### *Claim Rejections – 35 U.S.C § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mozilla and in further view of Ogle et al. (6,430,604) and DeSimone et al. (6,212,548).

In considering claim 1,

Mozilla discloses a distributed communication system in which a plurality of users associated with different realms (protocols) access the Internet via a corresponding PC through a service provider, a device for providing instant messaging between the users (lines 1-3 and 32-35).

Although Mozilla shows substantial features of the claimed invention, he is silent in regards to an IM manager associated with the PC of a first user and arranged to obtain a foreign protocol for communicating with another realm (protocol) and being further arranged to receive the unique identifier of a particular user associated with the another realm (protocol) from the server and to establish connection to the other user using the foreign protocol, as well as an IM server including a database with a listing of users currently connected to the Internet, each having a unique identifier. However, Ogle et al. whose invention is a method for enabling messaging systems to use alternative message delivery mechanisms, discloses such an IM

manager associated with the PC of a first user and arranged to obtain a foreign protocol for communicating with another realm and being further arranged to receive the unique identifier of a particular user associated with the another realm from the server and to establish connection to the other user using the foreign protocol (see Fig. 3, Registry 300; col. 7, lines 56 to col. 8, line 28). Additionally, Maurille, whose invention is a method for providing threaded combinations of instant messages, discloses such an IM server including an IM database with a listing of users currently connected to the Internet, each having a unique identifier (see Fig. 1, Server 100, PMD Database 108; col. 6, lines 44-57). Therefore, given the teachings of Ogle et al. and Maurille, it would have been obvious for a person having ordinary skills in the art to modify Mozilla by incorporating an IM manager and an IM server in to provide physical components that capable of maintaining the instant messaging information.

In considering claim 2,

Ogle et al. discloses a device further comprising a local database arranged to store a plurality of foreign protocols, each protocol being associated with a corresponding different realm (see Fig. 3, Registry 300; Fig. 4, Transformation Engine 403).

In considering claim 3,

Ogle et al. discloses a device wherein said IM server is arranged and constructed to connect to the Internet and to receive and transmit information to and from said IM manager via the Internet (see col. 5, lines 51-62).

In considering claim 4,

Ogle et al. discloses a device wherein said IM database is arranged to store information related to all said users (see Fig. 3, Registry 300; Fig. 4, Transformation Engine 403).

In considering claim 5,

Ogle et al. discloses a device further comprising a display arranged to show a list of current friends of a user and a selector operated by said user to select a friend from said list to establish communication (see Fig. 1, Display Device 24).

In considering claims 7 and 8,

Mozilla discloses a system wherein said users are arranged to communicate over the Internet by different IM service providers (SPs) (see page 1, lines 32-35).

Additionally,

Maurille et al. discloses the IM database being incorporated into one of said SPs (see Fig. 1, Server 100; PMB Database 108).

3. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mozilla and in further view of Ogle et al. (6,430,604).

In considering claims 6 and 16,

Mozilla discloses a distributed communication system in which a plurality of users associated with different realms (protocols) access the Internet via a corresponding PC through a service provider, a device for providing instant messaging between the users (lines 1-3 and 32-35).

Additionally,

Ogle et discloses a first and a second device for operation by said first and second users respectively, each device including a screen to display information, a selector or other input device for giving and receiving commands and selections, a communication port arranged to communicate with other users over the Internet, and an IM component arranged to establish IM

sessions during which said first and second users can exchange one or instant messages and other information over the Internet, said IM component including means for receiving a request for an IM session and means for generating a request for said IM session; said IM component including an IM database storing a protocol for the other realm (see Fig. 1; col. 4, lines 48-67; col. 6, lines 18-20 and 62-65; col. 7, lines 4-8; and 23-45); and

an IM database arranged to store a list of users registered to access instant messaging and being currently active together with their current location address (Fig. 3, Registry 300; col. 7, lines 56 to col. 8, line 28);

wherein said IM component is arranged to receive a command from said first user to establish said IM session with said second user and in response to said request said IM component is arranged to obtain the current address of said second user and to send an access request to said second user based on said address and said protocol and to establish said IM session if said access request is accepted (Fig. 3, Registry 300; col. 7, lines 56 to col. 8, line 28).

Although Mozilla and Ogle et al. show substantial features of the claimed invention, they fail to disclose using the IP addresses of the user for establishing communications between the users. Nonetheless, the use of IP addresses for uniquely identifying users is very well known in the art and would have been an obvious modification to the methods and systems disclosed by Mozilla and Ogle et al., as IP addresses are always used during any interactive communications session that is established using TCP or UDP. It would have been obvious for a person having ordinary skills in the art to modify Mozilla and Ogle et al. by using the IP addresses of the user for establishing communications between the users in order to provide a standard-wide means for identifying different computer network users.

4. Claims 10-15, 17-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mozilla and Ogle et al. as applied to claims 6 and 16 above, and further in view of DeSimone et al.

In considering claims 10, 11, 22, and 23,

Although Mozilla and Ogle et al. show substantial features of the claimed invention, they fail to disclose a system wherein each first and second device is arranged to display a window on said screen, said window identifying a list of friends of the corresponding user, as well as the first device being adapted to display a message area in one of said window and a separate window. However, DeSimone et al. whose invention is a method and system for maintaining a plurality of text chat conversations, discloses such a system wherein each first and second device is arranged to display a window on said screen, said window identifying a list of friends of the corresponding user, as well as the first device being adapted to display a message area in one of said window and a separate window (see Fig. 7, GUI 700, Windows 710 and 720). Therefore, given the teachings of DeSimone et al., it would have been obvious for a person having ordinary skills in the art to modify Mozilla and Ogle et al. by allowing each first and second device to display a window on said screen, said window identifying a list of friends of the corresponding user, as well as the first device being adapted to display a message area in one of said window and a separate window, in order to provide a GUI means for viewing the IM sessions.

Although Mozilla, Ogle et al., and DeSimone show substantial features of the claimed invention, they fail to specifically discloses a list of friends who are currently online. Notheless, the use of a list of friends who are currently online is very well known in the art and would have been an obvious modification to the methods and systems disclosed by Mozilla, Ogle et al., and

DeSimone et al., as many lists have been in use for a while, such as AOL's buddy list. It would have been obvious for a person having ordinary skills in the art to modify Mozilla, Ogle et al., and DeSimone et al. by using a list of friends who are currently online in to identify all possible buddies who are available for a text session.

In considering claims 12, 13, and 14,

DeSimone et al. discloses a system wherein each said device is adapted to receive commands from the respective user to establish a first IM session between said first user and said second user and a second IM session between said first user and a third user, said third user being identified in said window; wherein said first device is adapted to allow said first user to switch between said first IM session and said second IM session, said first and second IM sessions being active simultaneously; and wherein said first device is adapted to display in said message area messages with said second user during said first IM session and messages with said third user during said second IM session (see Figs. 5A-5C).

In considering claim 15,

Ogle et al. discloses a system wherein said first device is adapted to show characteristics of said friends (see Fig. 3, Status/Constraints 303).

In considering claims 17 and 18,

Ogle et al. discloses a method wherein each time one of said first and second users access the Internet, the corresponding device sends a message to an IM database indicating that the corresponding user is on line and said current address, wherein said step of determining said current address comprises retrieving said address from said IM database (see Fig. 3, Registry

300; col. 7, lines 56 to col. 8, line 28; Fig. 1; col. 4, lines 48-67; col. 6, lines 18-20 and 62-65; col. 7, lines 4-8; and 23-45; Figs. 5A-5C).

In considering claims 19 and 20,

DeSimone et al. discloses a method further comprising sending a connection request from the first to the second device for establishing said instant message session, as well as generating a response to said connection request by said second device accepting said connection request (see Figs. 5A-5C; col. 9, line 55 to col. 11, line 47).

### ***Conclusion***

5. Applicant's request for reconsideration of the finality of the rejection of the Office Action filed on 9/20/2002 is persuasive and, therefore, the finality of that action is withdrawn
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (Morris et al. 6336133, Guck 5,848,415).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon Johnson whose telephone number is (703) 305-4642. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3230.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 .

Marlon B. Johnson



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